

Remarks

Applicants have amended the file as requested by the Examiner. Claims 2-24 have been cancelled herein or previously without prejudice or disclaimer. Applicants reserve the right to file one or more continuation applications directed to the subject matter encompassed by all canceled claims. Upon entry of the present amendment, claim 1 will be pending.

Formal Matters**Specification Objections**

The specification was objected to because "trademarks are disclosed throughout the instant specification and not all of the them are capitalized or accompanied by the generic terminology" and because "it contains an embedded hyperlink and/or other form of browser-executable code." See, Paper No. 040405, pages 2-3, sections 4(a) and 4(b). In response, Applicants note that they will amend the specification to correct all improper trademark usage and delete all embedded hyperlinks upon receiving a notice of allowance for the present application.

The Examiner has requested a new title that is "clearly indicative of the invention to which the claims are directed". See, Paper No. 040405, page 3, section 4(c). In respect of this request, Applicants have amended the title as recommended by the Examiner to read: "Polynucleotides Encoding Human Secreted Proteins".

Claim Objections

Claims 1-4 were objected to because they make reference to Table 1A. See, Paper No. 040405, page 3, section 5. Deletion of Table 1A from the claims was requested. Applicants note that they have canceled claims 2-4 and have amended claim 1 to remove the allegedly objectionable language. Therefore, the objection of claims 1-4 is now moot.

Rejections under 35 U.S.C. §§ 10

The Examiner has rejected claims 1-10, 15-16, and 22 because the invention is allegedly not supported by either a credible, specific and substantial asserted utility or a well-established utility. See, Paper No. 040405, page 4, section 7. In particular, the Examiner alleges that "[t]here is no specific disease or specific function that is suggested for the polynucleotides or the encoded polypeptides." *Id.* In addition, the Examiner has rejected claims 8-10 under 35 U.S.C.

§ 101 because the claimed invention is allegedly directed to non-statutory subject matter. See, Paper No. 040405, page 8, section 8.

Preliminarily, Applicants have canceled claims 2-24 without prejudice or disclaimer. Therefore, the rejection of claims 2-24 under 35 U.S.C. § 101 has been rendered moot.

With respect to the remaining rejected claim 1, Applicants respectfully disagree and traverse. Contrary to the Examiner's position, the specification does indeed disclose at least one specific and substantial utility for the claimed invention. Initially, Applicants point out that the specification teaches that the HBIAE26 polynucleotide may be involved in regulating insulin production. See Table 1D, last column, pages 564-565. Further, the specification teaches that based in part on its ability to regulate insulin production, the HBIAE26 polynucleotide would be useful for diagnosing and/or treating diabetes mellitus. *Id.* Therefore, the specification clearly and specifically asserts a biological role for the HBIAE26 polynucleotide, i.e., regulation of insulin production, and correlates this activity to the treatment of a specific disorder, i.e., diabetes mellitus. As such, it logically follows that there is at least one patentable use for the polynucleotides of the present invention.

Applicants point out that the specification need only make *one* credible assertion of utility for the claimed invention to satisfy 35 U.S.C. § 101. See, e.g., *Raytheon v. Roper*, 724 F.2d 951, 958, 220 U.S.P.Q. 592, 597 (Fed. Cir. (1983), cert. denied, 469 U.S. 835 (1984). The disclosure of the use of HBIAE26 polynucleotides for a number of specific disorders does not negate the specificity of any one of those uses. Indeed, the M.P.E.P. at § 2107.02 states “[i]t is common and sensible for an applicant to identify several specific utilities for an invention . . .”. Further, “[i]f applicant makes one credible assertion of utility, utility for the claimed invention as a whole is established.” *Id.* See also, *In re Malachowski*, 189 U.S.P.Q. 432 (C.C.P.A. 1976); *Hoffman v. Klaus*, 9 U.S.P.Q.2d 1611 (Bd. Pat. App. & Inter. 1988).

Moreover, where the specification discloses a biological activity (e.g., regulation of insulin production), and reasonably correlates that activity to a disease condition (e.g., diabetes mellitus), the specification has sufficiently identified a specific utility for the invention. M.P.E.P. § 2107.01 at 2100-32 (emphasis added). In other words, so long as the correlation between the biological activity and the asserted use in a particular disease or condition is sufficient to convince one of skill in the art, then the specificity requirement of 35 U.S.C. § 101 is satisfied. See also, *Fujikawa v. Wattanasin*, 39 U.S.P.Q.2d 1895 (Fed. Cir. 1996). Applicants is satisfied. See also, *Fujikawa v. Wattanasin*, 39 U.S.P.Q.2d 1895 (Fed. Cir. 1996). Applicants

submit that, based on the present specification, the ordinary skilled artisan would readily recognize the specific asserted utility of the claimed polynucleotides.

Applicants note that the test for specificity is whether an asserted utility is specific to the subject matter claimed, in contrast to utility that would be applicable to the broad class of the invention. See M.P.E.P. § 2107.01 o : page 2100-32. Accordingly, the disclosed utility for the HBIAE26 polynucleotides discussed above is specific, in that not every polynucleotide is useful for the diagnosis and/or treatment of the above-mentioned disorders.

Furthermore, the Examiner alleges that the claimed invention is not supported by a substantial utility. As discussed above, Applicants assert that based on what is disclosed in the specification, coupled with what was known in the art on the earliest effective priority date of the present invention, it is reasonable that the claimed invention is useful in the diagnosis and/or treatment of certain disorders, and that such uses fulfill an unmet medical need. The M.P.E.P. states, "any reasonable use that an applicant has identified for the invention that can be viewed as providing a public benefit should be accepted as sufficient, at least with regard to defining a 'substantial' utility." See M.P.E.P. § 2107.01(I). Applicants thus assert that the claimed invention is supported by a substantial or "real world" utility.

In view of the above, Applicants maintain that a skilled artisan would not reasonably doubt that HBIAE26 polynucleotide can be used in diagnosing and/or treating diabetes mellitus. Thus, the presently claimed invention possesses at least one specific, substantial, and credible utility that constitutes a patentable utility under 35 U.S.C. § 101. Because Applicants' assertions of utility are sufficient to satisfy the requirements of 35 U.S.C. § 101, it is respectfully requested that the Examiner's rejection of currently pending claim 1 under 35 U.S.C. § 101 be reconsidered and withdrawn.

Rejections of Claims 1-10, 15-16, and 22 under 35 U.S.C. § 112, First Paragraph

A. Enablement

Claims 1-10, 15-16, and 22

Claims 1-10, 15-16, and 21 were rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement. See, Docket No. 040405, page 8, section 8. More particularly, the Examiner states, "since the claimed invention is allegedly not supported by either a specific and substantial asserted utility or a well established utility...one skilled in the art would not know how to use the claimed invention." id.

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Applicants have canceled claims 2-10, 15-16, and 22 without prejudice or disclaimer. Accordingly, the rejection with respect to these claims is now moot. With respect to pending claim 1, Applicants respectfully disagree and traverse.

For the reasons discussed above in response to the rejection under 35 U.S.C. § 101, the claimed invention is supported by a credible, specific, and substantial utility. Therefore, the Examiner "should not impose a 35 U.S.C. § 112, first paragraph, rejection grounded on 'lack of utility' basis unless a 35 U.S.C. § 101 rejection is proper." M.P.E.P. § 2107(IV) at 2100-28 (Rev. 1, Feb. 2000). Since the claimed invention complies with the utility requirement of 35 U.S.C. § 101, the rejection of the claim 1 under 35 U.S.C. § 112, first paragraph, based on lack of utility of the claimed invention, should be withdrawn.

Claims 1-10, 15-16, and 22 were also rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement because "the claims encompass an unspecified amount of fragments that are not supported by the instant specification" and the "claims reciting percent sequence identity...do not indicate where variations will occur or what variations can be tolerated in the sequence." See, Paper No. 040405, page 8, third paragraph.

Preliminarily, Applicants note that claims 2-10, 15-16, and 22 have been canceled. Accordingly, the enablement rejection with respect to these claims is now moot. Without acquiescing to the present rejection, claim 1 has been amended herein such that it no longer makes reference to percent identity of polynucleotide fragments. Therefore, Applicants submit that the enablement rejection of currently pending claim 1 under 35 U.S.C. § 112, first paragraph has been obviated. Thus, Applicants respectfully request that the Examiner's rejection of currently pending claim 1 under 35 U.S.C. § 112, first paragraph be reconsidered and withdrawn.

B. Written Description

Claims 1-10 and 15-16 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." See, Paper No. 040405, page 11, section 10.

In particular, the claims were rejected for allegedly lacking written description based on the following issues: 1) the claims are directed to fragments of the claimed nucleic acid and the

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encoded protein and the claims are absent functional language; 2) the claimed invention allegedly lacks complete deposit information; 3) the claims are directed to nucleotide sequences that comprise sequential deletions from the C or N terminus and there is no limit on the amount of nucleotides that can be deleted, and no demonstration of any conserved region or the effects of the modifications contemplated; and 4) the claims do not set forth the hybridization conditions that are considered to be stringent. *Id.* at pages 11-13.

In response, Applicants note that claims 2-10 and 15-16 have been cancelled. Furthermore, claim 1 has been amended such that the rejected language has been deleted. Accordingly, the written description rejection with respect to currently pending claim 1 is now moot. Thus, Applicants respectfully request that the Examiner's rejection of currently pending claim 1 under 35 U.S.C. § 112, first paragraph be reconsidered and withdrawn.

Indefiniteness Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 1-10 and 15-16 were rejected as indefinite under 35 U.S.C. §112, second paragraph, for "failing to set forth the subject matter, which applicant(s) regard as their invention." See, Paper No. 040405, page 14, section 11.

Claim 1

Claim 1 was rejected as allegedly indefinite for reciting: 1) full-length polypeptide encoded by the HBIAE26 cDNA Cl^o, ie ID in ATCC Deposit No: 209224 corresponding to SEQ ID NO:549; 2) hybridizing under stringent conditions; 3) A residues or T residues; and 4) said fragment has biological activity. See: Paper No. 040405, page 14, section 11, 2nd paragraph. In response, Applicants note that claim 1 has been amended to delete the allegedly indefinite language. Accordingly, the rejection to claim 1 has been obviated. Thus, Applicants respectfully request that the Examiner's rejection of claim 1 under 35 U.S.C. § 112, second paragraph be reconsidered and withdrawn.

Claim 3

Claim 3 was rejected for reciting "is hybridizable to SEQ ID NO:36" which is allegedly indefinite. See Paper No. 040405 page 15, first paragraph. Applicants note that claim 3 has been deleted. Accordingly, the rejection to claim 3 is now moot.

Claim 5

Claim 5 was rejected for reciting "comprises sequential nucleotide deletions" which is allegedly indefinite. See Paper No. 040405, page 15, second paragraph. Applicants note that claim 5 has been deleted. Accordingly, rejection of claim 5 is now moot.

Claims 15 and 16

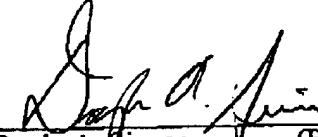
Claims 15 and 16 were rejected as allegedly indefinite "because the claims depend [sic] from a non-elected claim." Paper No. 040405, page 15, 3rd paragraph. Applicants note that claims 15 and 16 have been deleted. Accordingly, rejection of claims 15 and 16 is now moot.

Conclusion

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-342:

Respectfully submitted,


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